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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,004	12/29/2004	Raymond Hallot	33900-169PUS	7014

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COHEN, PONTANI, LIEBERMAN & PAVANE
551 FIFTH AVENUE
SUITE 1210
NEW YORK, NY 10176

EXAMINER

HOOK, JAMES F

ART UNIT	PAPER NUMBER
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3754

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04/16/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/520,004	Applicant(s) HALLOT ET AL.	
	Examiner James F. Hook	Art Unit 3754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 3-5,9,15-23,25,26 and 28-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-8,10-14,24 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/29/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Election/Restrictions

Applicant's election of the species of Figure 2 in the reply filed on January 16, 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 3-5, 9, 15-23, 25, 26, and 28-33 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on January 16, 2008.

It is noted that applicant elected claim 27, but not claim 24, however, claim 27 depended from claim 24 and the examiner has concluded that claim 24 would also read upon the elected species and has therefore considered claim 24 as an elected claim as well.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 6, 7, 10, 11, 13, 14, 24, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baylot (WO 00/40886) in view of Sigmund. The reference to Baylot discloses the recited device for thermally insulating at least one undersea pipe comprising a thermally insulating covering 4 made of a phase change material including an alkane material combined with wax provided around pipes 1, a second insulating layer 2 also provided around the pipes 1, an outer leak proof case 3₁ as seen in figure 15 to be rectangular in shape and thus meeting the limitations of claim 24 and 27, and where the pipe is surrounded in a continuous manner, where the phase change material meets all of the requirements of claims 10 and 13. The reference to Baylot discloses all of the recited structure with the exception of providing a container around the insulation layer within the outer protective case. The reference to Sigmund discloses that it is old and well known in the art of insulated pipes to provide an inner insulation 25, an outer insulation 28, a leak proof protective case 26 all surrounding a pipe 14, where the insulations can be separated by flexible containers seen as any of 90,103, 91,92,110 to separate the different layers of insulation materials or not to provide these coating layers. It would have been obvious to one skilled in the art to modify the insulation in Baylot by providing coating layers to act as flexible containers for the insulation layers as suggested by Sigmund where such teaches the equivalence of either not using coatings or providing coatings as desired where there are added beneficial qualities that

are provided by the coating layers where one skilled in the art would find it obvious to provide a layer if desired as Sigmund suggests.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baylot (WO 00/40886) in view of Sigmund as applied to claims 1, 2, 6, 7, 10, 11, 13, 14, 24, and 27 above, and further in view of Ohrn (438). The reference to Baylot as modified discloses all of the recited structure with the exception of specifically using the phase change material inside of the second insulation. The reference to Ohrn discloses that it is old and well known in the art to provide a pipe 12 with an insulation material including an inner phase change insulation layer 22, and a second outer insulation layer 24 of conventional insulation, where a outer case 14 is provided. It would have been obvious to one skilled in the art to modify the insulation layers in Baylot as modified such that the phase change material was located inside of the second insulation material as suggested by Ohrn where such is an alternate form of providing insulation to a pipe in subsea applications, where the outer insulation layer helps retain and protect the phase change material thereby insuring better temperature control of the inner pipe.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baylot (WO 00/40886) in view of Sigmund as applied to claims 1, 2, 6, 7, 10, 11, 13, 14, 24, and 27 above, and further in view of Davis. The reference to Baylot as modified discloses all of the recited structure with the exception of disclosing the use of heptacosane as the phase change material. The reference to Davis discloses that it is old and well known in the art of phase change materials to use heptacosane as a known phase change insulating material. It would have been obvious to one skilled in the art to

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modify the phase change material in Baylot as modified to be of any equivalent form of phase change material including heptacosane as suggested by Davis which teaches this is an old and well known phase change material used in insulation layers and would provide an alternate material having different properties than the alkane used in Sigmund as modified.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references to Leeser, Matthieu, Hallwood, Stine, Holman, Ohrn (290), Thiebaud, Codling and Janoff disclosing state of the art insulations and pipe insulation systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James F. Hook whose telephone number is (571) 272-4903. The examiner can normally be reached on Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James F. Hook/
Primary Examiner, Art Unit 3754

JFH